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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,672	02/25/2004	Dale C. Gledhill	15272.35.1	3017

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,672

Applicant(s)

GLEDHILL, DALE C. 

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on July 14, 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/786,672 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamstra et al. ('923).

Hamstra et al. disclose a foldable label package (10) for use with a device (40) comprising a first end (49); a second end (48); and an intermediate portion (12-16) having indicia (23 – indicia; 17- advertising space) disposed thereon specific to marketing the device (it is inherent to the device that the advertising space would include indicia specific to marketing the device), wherein the intermediate portion is selectively adjustable between a retracted position (as seen in figure 4) in which a portion of the intermediate portion is obscured, and an extended position (as seen in figure 2) in which at least a portion of the intermediate portion that was obscured is clearly seen or easily distinguished (in figure 4, information printed on the intermediate panels is obscured, but in figure 5, the information can clearly be seen), wherein the first

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end (49) of the label stock (18) carrying the labels (19, 20, 21 and 22) is adapted to be connected to the device (holes 42-45 enable the end 49 of the foldable label package to be connected to the prong 40). Therefore, at least a portion of the labels are indirectly connected to the device, since the labels are supported by the label stock (18) and an end (49) of the label stock is directly connected to the device (40).

The limitation of the label being used for marketing a device sets forth a functional limitation. While the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114. In the instant case, the claimed functional limitation can inherently be performed by Hamstra et al., since the foldable label package is to be displayed at a retail outlet.

Note: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Therefore, the reference applied is only required have the ability to perform the claimed function. In this case, the ends of Hamstra et al. is capable of performing the claimed function.

It is noted that the limitation "the device being selectively adjustable between a retracted position and an extended position" is located in the preamble of the claim in a functional limitation. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

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F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114.

Regarding claim 2, Hamstra et al. disclose the intermediate portion comprising a folded portion (see col. 2, lines 46-47).

Regarding claim 3, Hamstra et al. disclose the intermediate portion comprising a first and second portion, the second portion being positioned beneath the first portion (as seen in figure 4).

Regarding claim 5, Hamstra et al. inherently disclose at least a portion of the intermediate portion comprising flexible material to enable the panels of the intermediate portion to fold.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamstra et al.

Hamstra et al. disclose the claimed invention except for the intermediate portion comprising an S-shaped portion. It would have been an obvious matter of design choice

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to make the different portions of the intermediate portion of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Furthermore, applicant has failed to disclose that the shape of the intermediate portion is critical to the invention.

### ***Response to Arguments***

6. Applicant's arguments filed July 14, 2005 have been fully considered but they are not persuasive.

Applicant argues Hamstra et al. fail to disclose "A label for use with a device comprising a first end; a second end; and an intermediate portion... wherein at least a portion of the label is adapted to be connected to the device" because Hamstra does not teach that any part of the label is adapted to be connected to the device.

The examiner disagrees and asserts that the first end (49) of the label stock (18) carrying the labels (19, 20, 21 and 22) is adapted to be connected to the device (holes 42-45 enable the end 49 of the foldable label package to be connected to the prong 40). Therefore, at least a portion of the labels are indirectly connected to the device, since the labels are supported by the label stock (18) and an end (49) of the label stock is directly connected to the device (40) as stated above.

The limitation of the label being used for a device sets forth a functional limitation. While the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in

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terms of structure rather than function alone. See MPEP 2114. In the instant case, the claimed functional limitation can inherently be performed by Hamstra et al., since the foldable label package is to be displayed at a retail outlet.

It is noted that the limitation "the device being selectively adjustable between a retracted position and an extended position" is located in the preamble of the claim in a functional limitation. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114.

Regarding claim 4, applicant argues that Hamstra et al. fail to disclose the intermediate portion having an S-shaped portion. The examiner continues to maintain that since applicant has failed to disclose that the shape of the intermediate portion is critical to the invention, it would have been obvious to provide any desired shape for the intermediate portion as deemed necessary by the end user for a particular use.

For the reasons as set forth above, the rejections are maintained.

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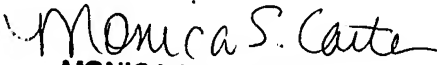
**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 16, 2005

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**